

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eric C. Anderson et al.

Examiner: Yogesh K. Aggarwal

Serial No. 09/213,131

Art Unit: 2622

Filed: 12/15/1998

Attorney Docket No. 1104-069/P126C

For: **METHOD AND APPARATUS FOR CORRECTING ASPECT RATIO IN A
CAMERA GRAPHICAL USER INTERFACE**

PETITION UNDER 37 § 1.182
TO REPLACE AN INFORMATION DISCLOSURE STATEMENT (IDS)

Mail Stop: Office of Legal Administration
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Honorable Commissioner:

This is a Petition under §1.182 to replace Patent Owner's original Information Disclosure Statement (IDS), which was filed on July 29, 2011 in the above-identified matter, with the concurrently filed Replacement IDS. The original IDS inadvertently included information which is subject to a protective order in International Trade Commission ("ITC") Investigation No. 337-TA-726.

A Replacement IDS is being filed concurrently. Also, a petition to expedite consideration of this petition to replace will be filed subsequently.

Further, the PTO is invited to treat this petition under another section of 37 CFR, if some other section appears more applicable than § 1.182.

For the convenience of the Patent Office, Patent Owner suggests that this replacement should be performed by first removing the "original IDS," including the IDS cover letter, related PTO Forms SB/08a, and all of the associated documents (both protected, i.e., subject to the protective order, and non-protected).

After this removal, then the Patent Office should enter into the record the concurrently filed herewith "Replacement IDS" including redacted PTO Forms SB/08a (including the Examiner's signature). This procedure should minimize the labor of the Patent Office, and minimize the risk of error.

At the request of the Office of Petitions, in an effort to expedite the filings of this and associated petitions, copies of the associated non-protected documents will be filed separately and as soon as possible, with a subsequent paper.

Furthermore, it is believed that the PTO Examiner need not go through the usual steps of initialing off on each document cited to indicate that the documents were considered, because the Examiner has already made such indication, and the Replacement IDS identifies only documents already considered (or at least lined through) by the Examiner. For this reason, the redaction of the PTO Forms SB/08a has been performed on the versions that have already been signed by the Examiner (and list some references which were lined through by the Examiner).

Specifically, the “Replacement IDS” consists of a copy of each form SB/08a signed by the Examiner on November 18, 2011 (with titles of documents that are subject to the protective order being redacted out). Again, copies of the non-protected documents (only those documents that have not been redacted out and thus are not subject to the protective order) will be filed separately and as soon as possible, with a subsequent paper.

The term “confidential information” is used herein to describe documents which have been determined to be confidential by the parties submitting them to the ITC, and have been marked accordingly. These documents are confidential with respect to the ITC investigation, and thus are subject to the ITC order.

The term “redacted IDS” refers to the redacted IDS attached to this petition, and is equivalent to the replacement IDS described above, except without any accompanying documents.

I. BACKGROUND (CONFIDENTIAL INFO UNDER PROTECTIVE ORDER)

Various patents are being asserted against various parties in an ITC investigation and associated litigation. Certain of these patents are generally related to the above identified matter. The Patent Owner is represented in the ITC investigation and the litigation by Pepper Hamilton, LLP and represented in this reexamination proceeding by Hershkovitz & Associates, LLC. Withrow & Terranova, PLLC handles a large number of patent prosecution matters for the Patent Owner and is assisting Hershkovitz & Associates, LLC in various reexamination matters. As can be gleaned from the prosecution history of this reexamination proceeding and other proceedings in which similar petitions are being filed, representative(s) of Patent Owner, Hershkovitz & Associates, LLC and Withrow & Terranova, PLLC have collaborated during interviews with the Examiner and other aspects of prosecution in the proceedings before the PTO.

To comply with the duty to disclose information that may be material to patentability in the various prosecution and reexamination matters, Withrow & Terranova gathered information from numerous sources, including related application and patent file wrappers, foreign counterpart file wrappers, and the like. As part of the information gathering, Withrow & Terranova requested that Pepper Hamilton, LLP provide it with any publically available information that may be material to the validity of any of the asserted patents, and thus related to the above identified matter. In response to Withrow & Terranova's request, Pepper Hamilton, LLP inadvertently included information that was subject to a protective order in the ITC proceeding along with numerous documents that were not subject to the protective order provisions.

Withrow & Terranova was not aware that Pepper Hamilton, LLP inadvertently included information that was subject to the protective order along with numerous documents that were not subject to the protective order. Not knowing that the information received from Pepper Hamilton, LLP included documents that were subject to the protective order and believing the documents should be submitted to the USPTO to comply with the duty of disclosure, Withrow & Terranova included the information received from Pepper Hamilton, LLP along with the information that had been gathered from other sources in an IDS that was submitted to the USPTO in the above identified matter. Similar filings were made in nine other matters, all of which will have similar petitions to replace filed therein. Notably, neither Withrow & Terranova

nor HersHKovitz & Associates are involved in any way in the pending ITC investigation or litigation actions involving Patent Owner Flashpoint's patents.

On or about August 11, 2012, Patent Owner, Withrow & Terranova and HersHKovitz & Associates were first made aware that potentially confidential information was accidentally submitted to the USPTO in the IDS. This petition is presented to remove the information which was subject to the protective order and which was submitted to the Patent Office, and to accept a Replacement IDS. The various parties have investigated the extent of the disclosure, and informed the ITC of the issue and the intended steps to mitigate further disclosure and retrieve all protected information. This petition furthers these efforts.

FlashPoint's litigation counsel, Pepper Hamilton, has contacted third parties whose information has been implicated and requested confirmation that all such material is confidential. Once this information is received from all of the third parties, FlashPoint will inform the PTO of any changes regarding the confidential designation of the documents.

Patent Owner has been lead to believe that the third party requester, who is also the owner of some of the documents that are subject to the protective order, intends to file in the near future a submission in support of this effort to expunge the protected material.

II. FACTS AND ARGUMENTS

A. Clear Identification of the Information to be Removed (Redacted IDS)

Appendix A is a list clearly identifying each document which is to be removed.

Appendix B is a redacted IDS. This redacted IDS consists of a copy of PTO Forms SB/08a which were signed by the Examiner, except that these forms have been redacted to delete all documents that are subject to the protective order. Since the original IDS filing is still in the possession of the PTO at the time of filing this petition, the Patent Office can easily ascertain that this redacted IDS includes fewer documents than listed with the originally filed IDS. Additionally, Patent Owner represents to the PTO that no additional documents are listed in this redacted IDS as compared to the original IDS.

Since the Examiner made patentability decisions based on documents previously considered, clearly, the Examiner's decision should not change adversely to Patent Owner as to patentability decisions based on fewer documents being considered. The redacted IDS includes

black areas which clearly identify the locations where the protected documents were listed previously. To keep the record clear, some of the documents in the redacted IDS were “lined through” by the Examiner to indicate that these documents were not considered by the Examiner. The redacted IDS is redacted in such a way that the “lined through” indications by the Examiner are still visible, although the name of the protected documents are still blanked out.

A copy of this redacted IDS is being separately filed as a replacement IDS, intended to replace the original IDS. At the request of the Office of Petitions, in an effort to expedite the filings of this and associated petitions, the associated non-protected documents will be filed separately and as soon as possible, with a subsequent paper, except for U.S. Patents and Patent Publications, which are readily available to the Examiner.

B. Clear Statement Regarding Protective Order

The information to be removed is material subject to a protective order.

Appendix C is a copy of Protective Order in Inv. No. 337-TA-726, dated July 9, 2010, from the ITC. Paragraph 3 prohibits disclosure of Confidential Business Information to anyone who is not authorized. The documents at issue are identified as confidential information by the parties that supplied them, and are identified as being subject to the protective order.

C. No Commitment to Retain Information (must “destroy or return”)

Initially, it is noted that it is believed that the PTO will hold that the applicable regulation herein is 37 CFR §1.182 which has no requirement regarding retention of expunged documents. Furthermore, the MPEP provision relative to a commitment to retain expunged information is not believed to be applicable to the present circumstances. Indeed, per the terms of the protective order, Patent Owner and its prosecution counsel and reexamination counsel are prohibited from having access to protected information which has been supplied by other parties. As such, Patent Owner cannot retain the removed information which has been supplied by other parties.

Patent Owner’s litigation counsel is obligated to destroy or return the protected information from other parties after the litigation concludes. Specifically, item 18 at page 9 of the protective order states, “[u]pon final termination of this investigation, each party that is subject to this order **shall destroy or return to the supplier all items containing confidential business information...**”

Thus, Patent Owner respectfully submits that the present situation is materially different from the situations of MPEP 724.05(I)(C) and MPEP 724.05(II)(D) which each require “a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted.” The MPEP has not considered the present unique situation, in which the information is subject to a protective order.

The protected information was inadvertently included in the original IDS, and the Patent Owner (and even its litigation counsel) does not have any legal authority to commit to retain protected information which has been supplied by other parties.

D. Submitted on Behalf of the Party in Interest (FlashPoint Technology, Inc.)

This petition to replace is being submitted on behalf of the real party in interest (FlashPoint Technology, Inc.) who originally submitted the information to the PTO.

E. Protected Information is Not Material

As confirmed by the Examiner, the protected information was not material to patentability.

III. RELATED CASES

The Present Patent which was subject to the above-captioned Reexamination Proceeding corresponds to one of the following 10 reexaminations or applications or patents. Petitions to replace are being filed in each of these 10 reexaminations or applications or patents:

- A. 95/001,431 6,134,606 IDS filed 7/18/2011 '606 reexam (RI1321367-606.A03; W&T 1104-267RE)– PENDING
- B. 95/001,420 6,163,816 IDS filed 7/18/2011 '816 reexam (RI1321366-816; W&T 1104-272RE) – PENDING
- C. 95/001,433 6,262,769 IDS filed 7/19/2011 '769 reexam (RI1321365-769.A01; W&T 1104-284RE) – PENDING
- D. 90/010,834 6,223,190 IDS filed 7/25/2011 '190 second reexam (R132594-834; W&T 1104-282RE2) –CERTIFICATE ISSUED
- E. 90/012,200 6,223,190 IDS filed 4/13/2012 '190 third reexam (R132594-200; W&T 1104-282RE3) –REQUEST FOR REEXAM DENIED
- F. 90/012,090 6,278,447 IDS filed 4/2/2012 '447 third reexam (R132596-C; W&T 1104-286RE3) –CERTIFICATE ISSUED
- G. 11/963,018 8,127,232 IDS filed 9/9/2011 (W&T 1104-040A) – PATENT ISSUED
- H. 09/213,131 8,102,457 IDS filed 7/29/2011 (W&T 1104-069) – PATENT ISSUED
- I. 11/466,629 IDS filed 9/15/2011 (W&T 1104-112) –PENDING
- J. 11/512,575 IDS filed 8/10/2011 (W&T 1104-209) – PENDING, ALLOWED

IV. RELIEF REQUESTED

The protected documents are like many needles distributed in a large haystack. There are 124 protected documents randomly (non-sequentially) distributed among 372 non-patent literature documents in the original IDS. Due to the graphical user interface of the PTO database (which does not identify non-patent literature documents by title), it will be extremely time consuming for the PTO to individually locate and then individually remove these 124 non-sequential protected documents.

For this reason, Patent Owner believes that the approach proposed below will be more efficient for the PTO, and will reduce the likelihood of errors.

Patent Owner hereby respectfully requests the PTO to permanently remove the original IDS filed July 29, 2011, including IDS cover letter, PTO Forms SB/08a, and all associated disclosure documents (both protected and non-protected).

Once the original IDS is removed, Patent Owner requests that the PTO enter the Replacement IDS which is being filed concurrently with this Petition, including a redacted PTO forms SB-08a (including the Examiner's signature). At the request of the Office of Petitions, in an effort to expedite the filings of this and associated petitions, the associated non-protected documents (except U.S. patents and patent publications, which are readily available to the Examiner and thus, were not previously provided) will be filed separately and as soon as possible, with a subsequent paper.

The overall result of the above two steps is to remove all documents that are subject to the protective order, leaving in the record all other previously filed documents that are not subject to the protective order.

V. CONCLUSION

The Office is invited to direct any questions or comments regarding this matter to the undersigned at the below-listed telephone number, facsimile number or e-mail address.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 50-1732.

Although Service is not believed to be required since the Reexamination Proceeding has already been concluded, Service is nevertheless being made as a courtesy to the third-party Requester during the reexamination phase of this Patent. Evidence of service of this Petition is attached hereto as the last page.

An early and favorable action is hereby requested.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: /Benjamin S. Withrow/

Benjamin S. Withrow
Reg. No. 40,876

August 31, 2012

Withrow & Terranova, PLLC
100 Regency Forest Drive
Suite 160
Cary, North Carolina 27518
TEL: (919) 238-2300
FAX: (919) 238-2301
E-MAIL: patents@wt-ip.com

Appendix A: List clearly identifying each document which is to be removed.

Appendix B: Redacted SB/08a forms

Appendix C: Protective Order Inv. No. 337-TA-726.